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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,543	07/03/2000	Michael Jeffers	15966-557 CIP	3281

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EXAMINER
SAOUD, CHRISTINE J

ART UNIT	PAPER NUMBER
1647	7

DATE MAILED: 12/07/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/609,543	JEFFERS et al.
Examiner	**Art Unit**
Christine Saoud	1647

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-62* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-62* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s).
18) ☐ Interview Summary (PTO-413) Paper No(s).
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-5, 41, 46, drawn to a polypeptide, classified in class 530, subclass 350, for example.

II. Claims 6-17, 42, 47, drawn to nucleic acids, host cells, vectors, recombinant methods of protein production, classified in at least class 435, subclass 69.1, for example.

III. Claims 18-20, 33, 43-48, drawn to antibodies, classified in class 530, subclass 387.1, for example.

IV. Claim 21, drawn to a method of detecting polypeptide using an antibody, classified in class 436, subclass 501, for example.

V. Claim 22, drawn to a method of detecting nucleic acid using a probe, classified in class 435, subclass 6, for example.

VI. Claims 23-24, drawn to a method of identifying a binding partner of the polypeptide, classified in class 436, subclass 501, for example.

VII. Claim 25, drawn to a method of modulating an activity of a polypeptide, classified in class undetermined, subclass undetermined (as the compound is not defined).

VIII. Claims 26-30, drawn to a method of identifying a therapeutic agent using cell expressing polypeptide, classified in class 435, subclass 4, for example.

IX. Claims 31-32, 44-45, drawn to a therapeutic agent, classified in class undetermined, subclass undetermined (as no structure for agent is provided).

X. Claims 34-35, 53, 55-57, drawn to a method of treatment by administration of a polypeptide, classified in class 514, subclass 2, for example.

XI. Claims 36-37, drawn to a method of treatment by administration of a nucleic acid, classified in class 514, subclass 44, for example.

XII. Claims 38-39, 54, 58, 60-62, drawn to a method of treatment by administration an agent, encompassing an antibody, classified in class 424, subclass 120.1, for example.

XIII. Claims 49-50, drawn to a method of screening using a transgenic animal, classified in class 800, subclass 2, for example.

XIV. Claim 51, drawn to a method of determining the presence or disposition to a disease by measuring the polypeptide, classified in class 435, subclass 7.1, for example.

XV. Claim 52, drawn to a method of determining the presence or disposition to a disease by measuring the nucleic acid, classified in class 435, subclass 6, for example.

XVI. Claims 58-62, drawn to a method of inhibiting cell growth by administration of a therapeutic agent, classified in class undetermined, subclass undetermined (as no structure is provided for the agent).

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of Group II could be used in an entirely different method, such as in a method of detection of the polynucleotide in a sample, rather than in a method of making the polypeptide.

4. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of Group I could be used for an entirely different purpose such as in the method of treatment, rather than for the production of antibodies of Group III.

5. Inventions I-III are also are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to chemically different compounds which can be made and used without each other. Furthermore, the inventions of Groups I-III lack a common utility which is based upon a common special technical feature which is disclosed as being responsible for the common utility.

6. Inventions I and (VI and X) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of Group I could be used in an entirely different manner, such as in either of the methods of Groups VI or X, or for the production of antibodies, for that matter.

7. Inventions I and (IV-V, VII-VIII, XI-XVI) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the polypeptide of Group I is not required for any of the methods of Groups (IV-V, VII-IX, XI-XVI).

8. Inventions II and (V, VIII, XI, XIII) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids of Group II could be used in an entirely different manner, such as in a method of making the polypeptide rather than in the methods of Groups V, VIII, XI, XIII).

9. Inventions II and (IV, VI-VII, X, XII, XIV-XVI) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the polypeptides of Group II are not required for any of the methods of Groups (IV, VI-VII, X, XII, XIV-XVI).

10. Inventions III and (V-VIII, X-XI, XIII, XV-XVI) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP

§ 806.04, MPEP § 808.01). In the instant case the different inventions are not required one for the other in that the antibody of Group III are not required for the methods of Groups V-VIII, X-XI, XIII, XV-XVI).

11. Inventions III and (IV, XII, XIV) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibodies of Group III could be used in an entirely different manner, such as in the purification of the polypeptide rather than in the methods of Groups (IV, XII, XIV).

12. Inventions (I-III) and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to chemically different compounds which can be made and used without each other. Furthermore, the inventions of Groups I-III and IX lack a common utility which is based upon a common special technical feature which is disclosed as being responsible for the common utility.

13. Inventions IX and (IV-VIII, X-XVI) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04,

MPEP § 808.01). In the instant case the different inventions are not required one for the other in that the agent of Group IX is not required for the methods of Groups (IV-VIII, X-XVI).

14. Inventions (IV-VIII, X-XVI) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to methods which have different method steps, starting materials and goals.

15. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the necessity for non-coextensive literature searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 7AM to 3PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556. If this number is out of service, please call the Group receptionist for an alternate number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

December 7, 2001

CHRISTINE J. SAOUD
PRIMARY EXAMINER

Christine J. Saoud